

Appl. No. 09/842,750
Amdt. dated September 15, 2004
Reply to Office Action of June 17, 2004

AFTER FINAL EXPEDITED PROCEDURE**REMARKS**

Claims 1 to 21 were pending in the application at the time of final examination. Claim 20 stands objected to for informalities. Claims 1 to 5, 16 to 19 and 21 stand rejected as anticipated for the first time. Claims 7 to 15 stand allowed. Claims 6 and 20 are objected to for being dependent on a rejected base claim, but would be allowable if rewritten in independent from including all of the limitations of the base claim and any intervening claims.

Claim 20 stands objected to for an informality and correction is required. Applicant has amended Claim 20 to depend from Claim 16 to correct the informality. Since correction of this informality was required, entry of this amendment is appropriate under Rule 116.

Claims 1 to 5, 16 to 19, and 21 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,065,087 hereinafter Keaveny. Applicant respectfully traverses the anticipation rejection of each of Claims 1 to 5, 16 to 19, and 21.

Applicant notes that Claim 1, as presented above is the claim originally presented in the Application. Nevertheless, in Paper No. 3, Claim 1 was rejected as obvious in view of U.S. Patent No. 6,477,165 combined with U.S. Patent No. 6,161,155. In Paper No. 5, Claim 1 was rejected as obvious in view of U.S. Patent No. 6,056,087 (Keaveny) combined with U.S. Patent No. 6,161,155. Now, in Paper No. 7, Claim 1 is rejected as anticipated. Thus, with no amendment to Claim 1, Applicant has received three different rejections and the last one was made final.

This is inappropriate on multiple levels. First, the three different rejections without a claim amendment is piecemeal examination. The MPEP indicates that such piecemeal

GUNNISON, MCKAY &
HODGSON, L.L.P.
Garden West Office Plaza
1900 Garden Road, Suite 220
Monterey, CA 93940
(831) 655-0880
Fax (831) 655-0888

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examination is to be avoided. Second, a new grounds of rejection, which was not necessitated by a claim amendment, should not be made final. The Examiner has provided no rationale for making the action final.

Finally, the Examiner is estopped from giving an anticipation rejection based on Keaveny. The Examiner has admitted on the record that Keaveny fails to teach the invention as recited in Claims 1 to 5, 16 to 19, and 21 by using Keaveny in an obviousness rejection in Paper No. 5 of these same claims. It is simply incongruous for the Examiner to admit on the record that Keaveny fails to teach the invention recited in Claims 1 to 5, 16 to 19, and 21 and then to assert that Keaveny teaches exactly the invention recited in Claims 1 to 5, 16 to 19, and 21. Accordingly, the record itself demonstrates that all Claims are in condition for allowance, and that this action has failed to comply with the requirements of the MPEP on multiple levels.

Moreover, the statements by the Examiner demonstrate that the level of skill in the art has not been applied in any consistent fashion; that standards for an anticipation rejection have not been followed; and that the difference between the various SCSI protocols, as known to those of skill in the art, has been ignored. The Examiner stated in part:

Since the reference teaches eliminating inefficiencies and bottlenecks, and increasing throughput. [Sic] In order to achieve these objectives for a system, the timing would be affected and therefore, would have to reduce the latency close to zero as the applicant claims.

Further the reference teaches the SCSI buses have 8, 16, and 32 bits of width and the transfer of data or commands through this bus would have to meet the required number of bits and therefore, these data or commands could be called or considered as packets of data or commands.

First, the Examiner confuses bus widths with protocols used to transmit information of the bus. The Examiner makes up

GUNNISON, MCKAY &
HODGSON, L.L.P.
Garden West Office Plaza
1900 Garden Road, Suite 220
Menlo Park, CA 94025
(831) 655-0880
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a definition of a packet based upon a bus width, i.e., "could be called." This is error. First, the SCSI protocol defines how the data is transmitted, e.g., packets or not packets, and the Claims recite a specific SCSI protocol. The Examiner cited no support for this conclusory statement that is inconsistent with the SCSI protocols, and is not based upon any citation to Keaveny that teaches correlating bus width with information transfer protocol. Moreover, it demonstrates that definitions are being used (i) that are not based on anything in the record, and (ii) that are unsupported, and contrary to, the level of skill in the art. The SCSI protocols and the standards for such are clearly within the level of skill and are provided in the background section of Applicant's disclosure as previously pointed out to the Examiner.

Next, the Examiner takes a statement out of context from Keaveny, and then draws conclusions that are unsupported by the reference. The reference stated:

. . . read operations through the bus bridges for critical read and write input/output ("I/O") transactions are avoided. The use of one internal bus for the Fibre Channel host adapters and a second internal bus for the SCSI-bus adapters eliminates direct contention between Fibre Channel host adapters and SCSI-bus adapters for a single internal bus, as commonly occurs in current FC/SCSI-bus multiplexers. The bottlenecks and inefficiencies characteristic to a number of currently-available FC/SCSI-bus multiplexers are eliminated,

Keaveny, Col. 2, lines 41 to 50. (Cited in rejection.)

Bottlenecks and inefficiencies characteristic to a number of currently available FC/SCSI-bus multiplexers are what is being described in this section. Two examples are described that address these bottlenecks and inefficiencies: 1) read operations though bus bridges; and 2) "direct contention between Fibre Channel host adapters and SCSI-bus adapters for a single internal bus." Eliminating bus contentions and avoiding

GUNNISON, MCKAY &
HODGSON, L.L.P.
Garden West Office Plaza
1900 Glendon Road, Suite 220
Monterey, CA 93940
(831) 655-0889
Fax (831) 655-0888

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read operations through bus bridges teach nothing concerning information transmission in the Packetized SCSI Protocol.

Thus, the Examiner's comments, as quoted above, would require taking these teachings of Keaveny out of the context of bus contentions and read operations through bus bridges associated with FC/SCSI-bus multiplexers, and applying the teaching in a different context, information transmission in the Packetized SCSI protocol. This is inappropriate for an obviousness rejection and so cannot be the basis for an anticipation rejection, which has a stricter requirement on the reference.

The MPEP directs:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. . . .

"The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.

MPEP § 2131, Eighth Edition, Rev. 2, p 2100-73 (May 2004)

The above quotation from the Examiner demonstrates that Keaveny fails to show "the identical invention . . . in as complete detail as is contained in the . . . claim." This is further evidence that the anticipation rejection of Claim 1 is not well founded. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 1.

With respect to the anticipation rejection of Claim 2, the Examiner cited the operation as being inherent in Keaveny. Applicant respectfully traverses the anticipation rejection of Claim 2. The Examiner has cited no teaching or mention in

GUNNISON, MCKAY &
HODGSON, L.L.P.
Gordon Wen Office Plaza
1900 Gordon Road, Suite 220
Menlo Park, CA 94025
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Keaveny of "the Packetized SCSI Protocol." Without such a citation, there can be no inherency basis. Moreover, the general description of the SCSI components relied upon by the Examiner fails to establish the location from which data is transmitted. Finally, Claim 2 depends from Claim 1 and so the above comments with respect to Claim 1 are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 2.

Claims 3 to 6 depend from Claim 2 and so distinguish over the combination of references for at least the same reasons as given above for the claims upon which they depend, which are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 3 to 6.

With respect to the anticipation rejection of Claims 16 to 20, Claims 16 to 20 have been previously rejected as obvious and further the previous rejection was based upon the rejection of Claims 7 to 15. Using the logic from the previous actions, since Claims 7 to 15 stand allowed, these claims should have also been allowed. Further, the Examiner admitted on the record that Keaveny failed to teach the invention in these claims. Therefore, the above comments with respect to Claim 1 and the record are applicable and are incorporated herein by reference. This is a completely new grounds of rejection that is provided for the first time in a final action, which is again inappropriate.

The Examiner has cited no teaching of the "Packetized SCSI protocol," and has cited no teaching of "the identical invention . . . in as complete detail as is contained in the . . . claim." Instead, the Examiner cites generally to a teaching of the prior art SCSI bus protocol. Knowledge of a protocol fails to teach the identical invention as required by the MPEP. For example, the Examiner has failed to cite a "start input line." Moreover, the above discussion of Keaveny

GUNNISON, MCKAY &
HODGSON, L.L.P.
Garden West Office Plaza
1900 Garden Road, Suite 220
Monterey, CA 93940
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with respect to Claim 1 also is incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 16.

Claims 17 to 20 depend from Claim 16 and so distinguish over the combination of references for at least the same reasons as given above for the claims upon which they depend, which are incorporated herein by reference. In addition, the Examiner again relies upon inherency, but fails to cite any teaching of the "Packetized SCSI Protocol." The general description of the prior art SCSI protocol cited by the Examiner fails to teach the components and the interconnections among the components recited in these claims. Further, the Examiner relies upon operations performed by a target device. The fact that the Examiner must mix operations between a SCSI initiator and a SCSI target is but further evidence that the rejection is not well founded. The target device is described as receiving the I/O command and so to the extent that the Examiner relies on operations of the target device, it teaches away from the inventions in these claims. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 17 to 20.

With respect to the anticipation rejection of Claim 21, Claim 21 was previously rejected as obvious and further the rejection was based upon the rejection of Claims 7 to 15. Using the logic from the previous actions, since Claims 7 to 15 stand allowed, this claim should have also been allowed. Further, the Examiner admitted on the record that Keaveny failed to teach the invention in this claim. Therefore, the above comments with respect to Claim 1 and the record are applicable and are incorporated herein by reference. This is a completely new grounds of rejection that is provided for the first time in a final action, which is again inappropriate.

The Examiner has cited no teaching of the "Packetized SCSI protocol," and has not cited any teaching of "the identical

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HODGSON, L.L.P.
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invention . . . in as complete detail as is contained in the . . . claim." Instead the Examiner cites generally to a teaching of operation of a SCSI target. The Examiner has failed to show any target device in Keaveny that generates a command block. Keaveny teaches, "the target has received and processes the I/O command." Col. 7, lines 24 and 25. Thus, Keaveny explicitly stated that the target receives the I/O command. Therefore, the very section relied upon by the Examiner demonstrates that the rejection is not well founded.

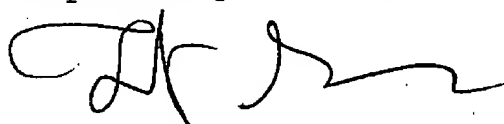
Further, the Examiner has cited no teaching of "a command information unit" or transferring information for the command information unit from two different locations--the hardware I/O command block and a register. Accordingly, the Examiner has failed to establish a prima facie anticipation rejection of Claim 21. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 21.

Claims 1 to 21 remain in the application. Claim 20 was amended. For the foregoing reasons, Applicant respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (703) 872-9306, on the date shown below.

Respectfully submitted,



Forrest Gunnison
Attorney for Applicant(s)
Reg. No. 32,899
Tel.: (831) 655-0880



Mona J. Marshall

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Date of Signature